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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,554	03/29/2001	Kazutoyo Maehiro	6514-7	4973

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EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2161

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,554

Applicant(s)

MAEHIRO, KAZUTOYO

Examiner

Susan Y. Chen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-28 and 30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13, 15-28 and 30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This office action is in response to amendment filed on 10/07/2005.

Claims 1–13, 15-28 and 30 are pending for examination; claims 1, 15-16 and 30 have been amended, claims 14, 29 and 31 have been canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 15-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over by MacNaughton et al. (U.S. Patent No. 6,433,795) of record, further in view of Junkin (U.S. Patent No. 6,193,610).

As to claims 1, 15-16 and 30, MacNaughton et al. (hereinafter referred as MacNaughton) discloses a computer system [e.g., see Abstract, Fig. 1] with apparatus, methods and computer program products as claimed by applicant, to perform the following processing, comprising:

a) a membership information retrieval server [e.g., see the Community Server (18), Fig. 1A-B] accepts requests from a group of user terminals [e.g., see the user's

terminal with Web browser (10), Fig. 1A] via the Internet communication protocols [e.g., TCP/IP (16, 34), or HTTP or FTP or IRC, etc; col. 6, lines 35-37] to perform the following functions, comprising:

- * storing the membership information from a group of users to a storage device [e.g., see col. 8, lines 29-33; the Membership Database (44), Fig. 1B], therein the membership information is updated dynamically by the user [e.g., col. 8, lines 33-42] and comprising video game information entered into and sent from each of the user terminals [e.g., col. 7, line 16; col. 8, lines 53 – col. 9, line 56].

- * retrieval and searching selected membership information from the storage device in respond to the request from the system user [col. 1, lines 54-61; col. 8, lines 10-23; col. 9, lines 41-45], wherein the selected membership information corresponding to online and offline users [e.g., see the CwholsHereTrackReq, CwholsHereTrackRsp provided (col. 17, lines 16-18) and CinviteTrackReq, CinviteTrackRsp (col. 17, lines 18-22) functions executed by the community server (col. 18, lines 23 – 50)];

- * displaying the membership information sent from the server on display of the user terminals [col.2, lines 19-23];

- * communicating to one or more members in the created temporary user list via messages flow entered by a user in a client/server model. [e.g. see the “who’s Online”, the real-time “Chat” and “Invitations” communication message services offered in a client(user)/server model as recited at col. 9, lines 1-27; col. 16, lines 15 - 59; col. 18, lines 42-51; col. 21, lines 36-45, wherein a second temporary user list that is associated

with the invitation action can be created by using extended scripting language; Fig.(s) 4-5 and associated texts].

Although MacNaughton discloses that the membership information entered into and sent from each of the user terminals including system membership status [e.g., col. 14, Login and Logout fields of the various request type table] for an on-line subscribers Internet service system [e.g., Abstract, lines 1-3], he did not specifically disclose that the membership information having the updated video game status.

However, Junkin discloses an interactive system having the updated video game status as claimed by applicant [e.g. Abstract; Fig(s). 4 A-B and associated texts; col. 8, lines 48 – col. 9, line 28; col. 10, lines 12-35].

Therefore, with the combined teachings of MacNaughton and Junkin in front of him/her, an ordinary skilled artisan at the time the invention was made would be motivated to further modify the combined system with the video game status as claimed by applicant, because by doing so, the modified system will provide a user friendly real-time video game status and allows the player to make selections as desired.

As to claims 2-13 and 17-28, except the features recited in claims 1, 15-16 and 30, the combined system of MacNaughton and Junkin further discloses that the system having the features as claimed by applicant, including:

a) a determination system [e.g., MacNaughton: the unit148, Fig. 4] that determines whether each of the group of the user terminals is current online [e.g., MacNaughton: see the unit150, Fig. 4], wherein the communication server [e.g.,

MacNaughton: the unit 140, Fig. 4] imports the determination results into the membership information and then sends the membership information to the user terminal [e.g., MacNaughton: col. 8, lines 43-65; Fig. 4; col. 16, lines 15 - 48];

b) the membership information includes user name, text , etc, which can be updated whenever necessary from the user terminal online activities [e.g., MacNaughton: col. 8, lines 29-39; Junkin: col. 10, lines 12-35].

Response to Arguments

Applicant's arguments filed on 10/07/2005 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, the Office points out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, as cited in the above paragraphs, MacNaughton specifically discloses a computer system [e.g., see Abstract, Fig. 1] comprising: a membership information retrieval server [e.g., see the Community Server (18), Fig. 1] accepts user inputs including "Who's Online", real time Chat", "Invitations", "email", "Games" messages from a group of user terminals [e.g., see the user's terminal with Web

Art Unit: 2161

browser (10), Fig. 1; col. 5, lines 47-67; col. 6, lines 1-24 and col. 7, lines 1-13] to perform the functions as discussed above and recited by applicant. Additionally, Junkin discloses an interactive system having the updated video game status as claimed by applicant [e.g. Abstract; Fig(s). 4 A-B and associated texts; col. 8, lines 48 – col. 9, line 28; col. 10, lines 12-35]. Hence, one of ordinary skill in the art at the time the invention was made would in fact, contrary to applicant's arguments, look to incorporate the technique taught by Junkin in MacNaughton's system for constructing a combined interactive client/server searching and navigation system that provides a user friendly real-time video game status and allows the player to make selections based on user's input messages. Therefore, the examiner contends that there would be most definitely a reasonable expectation of success.

The examiner further disagrees with applicant's arguments that "MacNaughton does not recognize the need for an additional search capability to refine and focus the degree of similarity."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an additional search capability to refine and focus the degree of similarity and how to do this search) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the examiner disagrees with applicant arguments that “There is no mention or suggestion in MacNaughton of searching for more than whether someone is a member of the community and online.”

In response to these arguments, the examiner points out that MacNaughton clearly discloses his system provides a community server [e.g., the unit 18, Fig. 1] which interacts with the Web Browser navigation messages [e.g., “Who’s Online” and others] and the Membership database [e.g., the unit 44, Fig. 1] to provide a list of members current in the community [e.g., col. 6, lines 64 – col. 7, lines 6] and other associated correspondence.

As to the rest of the arguments, they merely rehash issues already addressed on record. Thus, the examiner maintains the same rejection.

Conclusion

Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2161

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

January 6, 2006



UYEN LE
PRIMARY EXAMINER